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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,474	08/29/2001	Yasuo Shinohara	Q65911	4884

7590 06/17/2003

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EXAMINER

WILLS, MONIQUE M

ART UNIT	PAPER NUMBER
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1746

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DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A2-6

Office Action Summary

Application No.

09/940,474

Applicant(s)

SHINOHARA ET AL.

Examiner

Wills M Monique

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 4 & 9-11 are objected to because of the following informalities: "the electrochemically stable substance" lacks antecedent basis. Appropriate correction is required.

Claim 3 & 9-11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The spacer comprising an electrochemically stable substance is an inherent characteristic of the spacer of claim 1. Therefore, claim 3 does not further limit the spacer of claim 1.

Claim Rejections - 35 USC § 112

~~The following is a quotation of the second paragraph of 35 U.S.C. 112:~~

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims 10-11 are in improper form because a multiple dependent claim can not depend on another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurauchi et al. U.S. Patent 5,691,047.

Kurauchi teaches a porous multi-layer film separator for a nonaqueous electrolyte battery comprising at least three united polyolefin layers, in which at least one layer is polyethylene (PE) and at least one layer is polypropylene (PP) placed in contact with the polyethylene layer (abstract). The polypropylene film is a shutdown layer having a shutdown temperature of 170°C or higher (col.2 , lines 60-68). The polypropylene-films serves as both a spacer having a form of a porous film and a heat-resistant microporous layer (Fig. 1 & col. 2, lines 40-55). The polypropylene layers have a thermal durability to maintain the shutdown condition up to a certain temperature (col. 2, lines 40-50).

The Kurauchi does not expressly disclose the spacer layer placed on the surface of the heat-resistant layer. The reference does not expressly disclose the spacer comprises an electrochemically stable substance that has a static friction coefficient between the separator surface and a stainless steel surface ground by a 1000 grit polishing paper is 0.5 or less.

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However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ polypropylene porous film on the surface of the heat-resistant polyethylene layer, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. More specifically, if numerous multi-layer films are employed, the PP layers would encompass PE layers providing PP spacers and/or shutdown layers juxtaposing the heat-resistant layer.

Regarding the spacer consisting of an electrochemically stable layer with said static friction coefficient, it would be reasonable to expect the polypropylene spacer of Kurauchi to exhibit such characteristics because it appears to be made from the same polyolefin material as the subject invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yu U.S. Patent 6,080,507 teaches a tri-layer battery separator. Yu U.S. Patent 5,691,077 teaches a shutdown, tri-layer battery separator. Spotnitz U.S. Patent 6,180,280 teaches a tri-layer battery separator.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Monique Wills whose telephone number is (703) 305-0073. The Examiner can normally be reached on Monday-Friday from 8:30am to 5:00 pm.

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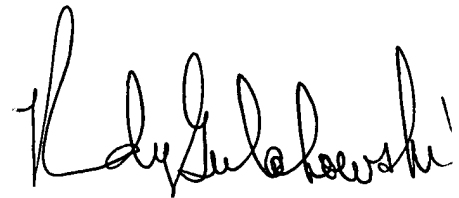
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

If attempts to reach Examiner by telephone are unsuccessful, the Examiner's supervisor, Randy Gulakowski, may be reached at 703-308-4333.

The unofficial fax number is (703) 305-3599. The Official fax number for non-final amendments is 703-872-9310. The Official fax number for after final amendments is 703-872-9311.

Mw

05/31/03

A handwritten signature in black ink, appearing to read "Randy Gulakowski", is written over a horizontal dashed line.

RANDY GULAKOWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700